

Attorney Docket No. P12044

**REMARKS/ARGUMENTS****1.) Claim Amendments**

The Applicant has amended claims 1, 2, 6-10, 12, 13, 16-21, 23-25. Accordingly, claims 1-25 are pending in the application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

**2.) Claim Rejections – 35 U.S.C. § 112**

The Examiner has rejected claims 23 and 24 under 35 U.S.C. § 112, first paragraph. Specifically, for claims 23 and 24 the Examiner notes that the disclosure and the drawings fail to mention how the size of the difference is determined or calculated and how the difference level itself can be used for determining whether a new cell belongs to any group to which no member of the active set belongs. The Applicant respectfully traverses this rejection.

The element of the claims in question is reproduced below:

the method comprising determining whether to establish a new radio link between a mobile station and a new digital cell, by determining whether a quality value of the new radio link exceeds a threshold set at a difference level below a best digital cell in the active set, the size of the difference level depending on whether the new digital cell belongs to any group to which no member of the active set belongs.

The Applicant respectfully submits that enabling support for this element may be found by one skilled in the art throughout the document. For instance, one skilled in the art would know that in some embodiments, the "difference level" may be just a delta between the threshold amount relating to the best digital cell and the threshold required when aspects of the invention are implemented. This required threshold amount is discussed throughout the Specification. After reading the Specification, one skilled in the art would recognize that the required threshold amount level for the various embodiments of the invention is a function of the costs and penalties associated with the particular situation (Specification, page 8, lines 3 to 6, and page 8, lines 19-26). As discussed on page 8, lines 28-34 of the Specification:

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*The costs associated with the zones can differ, making it easier for a mobile station belonging to zone 1 to establish links-with cells in zone 2 than for a mobile station belonging to zone 2 to establish links with cells in zone 1, or vice versa, if desired. Moreover, the costs can be varied by the network operator at different times etc.*

Thus, one skilled in the art would know that costs are established by the operator depending on specific network conditions. Furthermore, the Specification discusses the calculation of penalties on page 13, line 12 to page 14, line 5. Thus, the Applicant respectfully asserts that one skilled in the art, after reading the Specification, would know how to set costs and penalties in order to determine the required threshold level. One skilled in the art would know that the required threshold level determines the size of the difference and, thus, how the difference level is used for determining whether the new cell belongs to any group.

The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984). An inventor need not explain every detail since he is speaking to those skilled in the art. *In Re Howarth*, 654 F.2d 103, 105, 210 USPQ 689, 691 (CCPA 1981).

The amount of guidance or direction needed to enable the invention is inversely related to the amount of knowledge in the state of the art as well as the predictability in the art. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). The "amount of guidance or direction" refers to that information in the application, as originally filed, that teaches exactly how to make or use the invention. The more that is known in the prior art about the nature of the invention, how to make, and how to use the invention, and the more predictable the art is, the less information needs to be explicitly stated in the specification. In contrast, if little is known in the prior art about the nature of the

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invention and the art is unpredictable, the Specification would need more detail as to how to make and use the invention in order to be enabling.

The Applicant asserts that given the Specification and the predictability of the art, anyone skilled in the art would know how to assign costs and penalties, and therefore determine a difference level of the thresholds. Consequently, providing such detail would only obscure the inventive aspects of the invention.

The Applicant admits that the term "a threshold set at a difference level" is not used in the Specification. However, it is well settled law that an adequate description under the first paragraph of 35 U.S.C. 112 does not require literal support for the claimed invention. . . . Rather, it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that an appellant had possession of the concept of what is claimed. *Ex parte Parks*, 30 USPQ 2d 1234, 1236-37 (B.P.A.I. 1993). According to the MPEP, the subject matter of the claim need not be described literally (i.e., using the same terms or in *haec verba*), MPEP 2163.02.

The concepts of "costs" and "penalties" to establish threshold levels are used throughout the Specification. Thus, there should be no question, therefore, that to one skilled in the art, there is ample enablement throughout the specification and drawings for the term "a threshold set at a difference level" even though the literal phrase is not used.

The Applicant, therefore, respectfully requests that the §112 rejection with respect to claims 23 and 24 be withdrawn.

The Examiner has rejected claim 25 under 35 U.S.C. § 112, first paragraph. Specifically, the Examiner states that the limitation of a candidate cell being compared with two different thresholds for determining if said candidate cell should be added into an active list introduces new matter. The Applicant respectfully traverses this rejection.

The Applicant maintains that support for claim 25 can be found throughout the Specification. As an illustrative example, however, the Applicant notes that one skilled in the art would know that the various thresholds are functions of the penalties and costs described throughout the Specification. Thus, for instance, on page 11, lines 2-12, the Specification states:

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Thus, if for example the active set at one moment consists of cell A.a only, there is no penalty associated with cells A.b or A.c, since they both belong to the same handover zones as cell A.a. Thus, radio links to those cells can be added if they meet the usual thresholds.

However, adding cell B.b would mean introducing handover zone 2, and a radio link to this cell is added only if the required threshold is met even after application of the penalty associated with handover zone 2.

The above quotation discusses a situation where cells A.b or A.c are members of a first group and no penalty is applied. Furthermore, "the cells can be added if they meet the usual thresholds." This, of course, refers to a first threshold. The second paragraph discusses a situation where cell B.b is a member of a second group. Cell B.b is only added if it meets "the required threshold" after the application of the penalty, which is a second threshold. Thus, there is support for: determining if the candidate digital cell is a member of the first group; if the candidate digital cell is a member of the first group, then applying a first threshold standard to determine if the candidate digital cell should be added to the active set; if the candidate digital cell is not a member of the first group, then applying a second threshold standard to determine if the candidate digital cell should be added to the active set.

The Applicant, therefore respectfully requests that the §112 rejection with respect to claim 25 be withdrawn.

### 3.) Claim Rejections – 35 U.S.C. § 102(e)

The Examiner rejected claims 1-3, 10-14 and 21-25 under 35 U.S.C. § 102(e) as being anticipated by Haberman, et al. (US 6,035,197). The Applicant has amended independent claims 1, 12, 23, 24, and 25 to better define the intended scope of the claimed invention. Specifically, the independent claims now refer to digital cells which are considered in groups. In contrast, Haberman does not divide the digital cells into groups. Furthermore, Haberman would have no reason to divide the digital cells into groups. Thus, as applied to the amended claims, a 102 rejection based on Haberman is not appropriate. The Examiner's consideration of the amended claims is respectfully requested.

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Claims 2-3, 10-11, 13-14 and 21-22 depend from the amended independent claims and recite further limitations in combination with the novel elements of the independent claims. Therefore, the allowance of the claims dependent is also respectfully requested.

**4.) Claim Rejections – 35 U.S.C. § 103(a)**

The Examiner rejected claims 4 and 15 under 35 U.S.C. § 103(a) as being unpatentable over Haberman in view of Achour, et al. (WO 01/03464). The Applicant has amended the independent claims 1 and 12 to better define the intended scope of the claimed invention. Specifically, the independent claims (which are incorporated into the dependent claims 4 and 15) now refer to digital cells are considered in groups. Haberman does not divide the digital cells into groups. Thus, not all claim elements are taught by the combination. Furthermore, Haberman would have no reason to divide the digital cells into groups. Thus, as amended, there is no motivation for combining Haberman with Achour. The Examiner's consideration of the amended claims is respectfully requested.

The Examiner rejected claims 5-7 and 16-18 under 35 U.S.C. § 103(a) as being unpatentable over Haberman in view of Lind, et al. (US 6,163,694). The Applicant has amended the independent claims 1 and 12 to better define the intended scope of the claimed invention. Specifically, the independent claims (which are incorporated into the dependent claims 5-7 and 16-18) now refer to digital cells are considered in groups. Haberman does not divide the digital cells into groups. Thus, not all claim elements are taught by the combination. Furthermore, Haberman would have no reason to divide the digital cells into groups. Thus, as amended, there is no motivation for combining Haberman with Lind. The Examiner's consideration of the amended claims is respectfully requested.

The Examiner rejected claims 8-9 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Haberman in view of Lind, further in view of Rinne, et al. (US 6,574,473). The Applicant has amended claims 8-9 and 19 to better define the intended scope of the claimed invention. Specifically, the claims 8-9 and 19 now refer to digital cells are considered in groups. Haberman does not divide the digital cells into

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groups. Thus, not all claim elements are taught by the combination. Furthermore, Haberman would have no reason to divide the digital cells into groups. Thus, as amended, there is no motivation for combining Haberman with Lind and Rinne. The Examiner's consideration of the amended claims is respectfully requested.

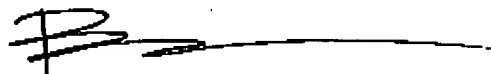
The Examiner rejected claim 20 under 35 U.S.C. § 103(a) as being unpatentable over Haberman in view of Rinne. The Applicant has amended claim 20 to better define the intended scope of the claimed invention. Specifically, claim 20 now refers to digital cells are considered in groups. Haberman does not divide the digital cells into groups. Thus, not all claim elements are taught by the combination. Furthermore, Haberman would have no reason to divide the digital cells into groups. Thus, as amended, there is no motivation for combining Haberman with Rinne. The Examiner's consideration of the amended claims is respectfully requested.

### CONCLUSION

In view of the foregoing remarks, the Applicant believes all of the claims currently pending in the Application to be in a condition for allowance. The Applicant, therefore, respectfully requests that the Examiner withdraw all rejections and issue a Notice of Allowance for all pending claims.

The Applicant requests a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



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Date: 9/22/04

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